

REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow. Claims 1-7, 9-13, 15-18 and 20-22 are cancelled and claim 8 has been amended. After amending the claims as set forth above, claims 8, 14 and 19 are pending in this application. Support for the present amendment is found at page 24 for compound I-1b and pages 31-47 for the rest of the compounds.

Rejections For Obviousness-Type Double Patenting

Applicants submit that in light of the amended claims, claim 1-5 and 7-11 of US Patent No. 6,384,075 and claims 1, 5 and 6 of US Patent No. 6,172,113 no longer render the present claims unpatentable under the judicially created doctrine of obviousness type double patenting.

Provisional Rejections for Judicially Created Double Patenting

Applicants request that the Examiner withdraw the provisional judicially created double patenting rejection over Application No. 10/297,065. With the submission of this response, applicants believe that all outstanding rejections have been overcome. MPEP § 804 I. B., reproduced below, states that when a provisional double patenting rejection is the only rejection remaining, the Examiner should withdraw the rejection and allow the application to issue as a patent.

The "provisional" double patenting rejection should continue to be made by the examiner in each application as long as there are conflicting claims in more than one application unless that "provisional" double patenting rejection is the only rejection remaining in one of the applications. If the "provisional" double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent, thereby converting the "provisional" double patenting rejection in the other application(s) into a double patenting rejection at the time the one application issues as a patent.

If the "provisional" double patenting rejections in both applications are the only rejections remaining in those applications, the examiner should then withdraw that rejection in one of the applications (e.g., the application with the earlier filing date) and permit the application to issue as a patent. The examiner should maintain the double patenting rejection in the other application as a "provisional" double patenting rejection which will be converted into a double patenting rejection when the one application issues as a patent.

Rejections Under 35 USC § 103

Applicants contend that the present invention is not obvious over WO 97/00853A because the generic teachings of this patent would not motivate one of ordinary skill in the art to arrive at the present invention rather than over the large number of other possible variations disclosed in WO 97/00853. Nor would one of ordinary skill in the art have a reasonable expectation of success of the superior results of the present compounds as they display unexpectedly superior results that could have not been presaged by the disclosure of WO 97/00853A.

The antagonistic activities of the compounds of claim 8 for PGD₂ and TXA₂ are described in Tables 31 and 32. For example, IC₅₀ values of the compound (I-1B) for PGD₂ and TXA₂ are 0.0043 and 0.003 μ M respectively. As shown in Table 33, the IC₅₀ values of the compound (B-1) which is shown for comparative purposes and described as Compound (2a-194) in WO 97/00853 (US 6,384,075 and US 6,172,113) are 0.0082 and 3.8 μ M respectively. Almost antagonistic activities for TXA₂ of the compounds exemplified above are hundred times stronger than that of the compound of WO 97/00853. Therefore, applicants believe that amended claim 8 is sufficient to overcome the rejection under 35 U.S.C. § 103. Therefore, applicants contend that the outstanding rejection for obviousness under 35 USC § 103 is improper and should be withdrawn.

Rejection Under 35 USC § 112, Second Paragraph

Claim 8 has been amended to render the 112 rejection moot.

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested. The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Respectfully submitted,

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